

REMARKS/ARGUMENTS

The Examiner is requiring restriction to one of the following groups:

- Group I: Claim 17, drawn to a method of preparing a storage-stable aqueous dispersion; and
- Group II: Claims 18-26, drawn to a storage-stable aqueous dispersion and Claims 28 and 29, drawn to an article coated with said storage-stable aqueous dispersion; and
- Group III: Claims 27 and 30, drawn to a method of using a storage-stable aqueous dispersion.

Applicants elect, with traverse, Group II, Claims 18-26 & 28-29, for examination.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Office if restriction is not required (MPEP §803). The burden is on the Office to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP §803). Moreover, when citing lack of unity of invention in a national stage application, the Office has the burden of explaining why each group lacks unity with the others (MPEP § 1893.03(d)), i.e. why a single general inventive concept is nonexistent. The lack of a single inventive concept must be specifically described.

The Office alleges that the Groups do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reason: “The instant U.S. national stage application under 35 U.S.C. 371 lacks unity of invention because even though the inventions of these groups require the technical feature of a *storage-stable aqueous dispersion*, this technical feature is not a *special* technical feature as it does not make a contribution over the prior art in view of:

- (A) the teachings of Miyamoto et al. (US Pat. No. 5,656,701) in view of Kobayashi (US Pat. No. 5,662,966) – *see rejection set forth in section 9 of the previous office action*; and

- (B) the teachings of Wissing et al. (US 2006/00031666), as supported by provisional application 60/584,726.”

However, Annex B of the Administrative Instructions under the PCT, paragraph b (Technical Relationship), states (with emphasis added):

The expression “special technical feature” is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, *considered as a whole*, makes over the prior art. The determination is made on the contents of the claims as *interpreted in light of the description* and drawings (if any).

Applicants respectfully submit that the Office did not consider the contribution of the invention, *as a whole*, over the disclosure of the cited reference. Applicants also respectfully submit that the Office has not provided any indication that the contents of the claims *interpreted in light of the description* was considered in making the assertion of a lack of unity. Therefore, the Office has not met the burden necessary to support the assertion of a lack of unity of the invention.

For the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Applicants therefore request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

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Respectfully Submitted,

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